



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of

Leo I. RAINER et al.

Group Art Unit: 3753

Application No.: 09/802,883

Examiner: L. CIRIC

Filed: March 12, 2001

Docket No.: 120538

For: INTEGRATED VENTILATION COOLING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

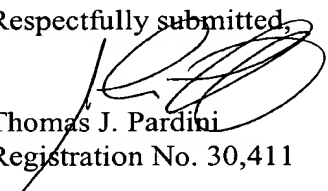
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the June 28, 2005 Final Rejection in this application.

A Notice of Appeal and fee in the amount of \$250 is filed concurrently herewith. The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No. 15-0461. No Amendments are being filed at this time. The review is requested for the reasons stated in the attached sheets.

Respectfully submitted,


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John W. Fitzpatrick
Registration No. 41,018

TJP:JWF/axl

Date: September 28, 2005

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REMARKS

Claims 32-51 are pending in this application and stand finally rejected. The June 28, 2005 Final Office Action rejects claims 32-44 under 35 U.S.C. §102(b) as anticipated by U.S. Patent Application 4,775,944 to Nakamura and claims 45-51 are withdrawn.

Applicants respectfully submit that the legal and factual basis of the prior art rejection contains clear legal and factual deficiencies and fails to establish a *prima facie* case in support of the rejection. The Final Office Action asserts that Nakamura discloses each and every feature recited in the rejected claims including a controller, operably connected to the sensor system and the air delivery system. The Final Office Action further asserts that "little or no patentable weight is given to purely functional language and optional/conditional limitations in the apparatus claims." Finally, in the Response to Arguments section at page 4, paragraph 1, of the Final Office Action, a human being is alleged to perform a function of the claimed controller.

Applicants respectfully submit that Nakamura fails to disclose that which is asserted in the Final Office Action.

I. Omission of Essential Elements Needed for *Prima Facie* Rejection

Independent claim 32 of the rejected claims recites, in pertinent part,

[A] system for using outside ventilation air to maintain indoor comfort and air quality, comprising ... a controller, operably connected to the sensor system and the air delivery system, that: receives an outdoor air temperature and an indoor air temperature detected by the sensor system; stores the detected outdoor air temperature and the detected indoor air temperature detected by the sensor system; calculates a predicted indoor temperature range and a predicted outdoor temperature range based on the stored outdoor air temperature and the stored indoor air temperature; and regulates operation of the air delivery system as a function of predicted indoor and outdoor air temperature ranges and a predetermined indoor temperature range.

Nakamura discloses a controller 12 that relays messages to an output terminal device 14 (C. 3, L. 1-5). The messages displayed to the consumer include promotional

information which teach a desired or preferable operation of an air conditioning and/or hot water system, incentive information which teaches the advantages to the consumer when the consumer cooperates in making the heat load even or saving energy, discouragement information which indicates the irrationality of certain kinds of operation of the air conditioner apparatus or warns not to operate the air conditioner in such a fashion, and penalty information which imposes a penalty when certain kinds of operation of the air conditioner are performed (C. 3, L. 44-65). The consumer can operate the air conditioning and/or hot water supply and apparatus by obeying the displayed message (C. 4, L. 1-13). Thus, the controller 12 disclosed in Nakamura fails to correspond to the controller recited in the rejected claims. Because Nakamura fails to disclose each and every feature of the rejected claims, there is an omission of an essential element needed for a *prima facie* rejection of the claims.

II. Legal and/or Factual Deficiency in Claim Rejections

a. The first legal deficiency resides in the standard of interpretation of the claims during patent examination. At page 2 of the Final Office Action, it is alleged that "claims in a pending application should be given their broadest reasonable interpretation" relying on *In re Pearson*, 181 USPQ 641 (CCPA 1974). The court in *In re Pearson* relied on, and cited *In re Prater*, 415 F.2d 1493 (1969) for the statement regarding claim interpretation. In *Prater*, the standard for claim interpretation during examination is "claims yet unpatented are to be given broadest reasonable interpretation consistent with specifications during examination of patent application (Emphasis added). Thus, according to *Prater*, the standard is not broadest reasonable interpretation, but rather is broadest reasonable interpretation consistent with the specification. The standard recited in *Prater* is also the standard of claim interpretation under MPEP §2111 which recites that "during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification." Thus, it is legal error to

interpret the controller recited in the rejected claims so broadly that "any prior art controller operably connected to a sensor system and an air delivery system be readable on the controller as recited in the claims of the instant invention" as set forth in the Final Office Action at page 2.

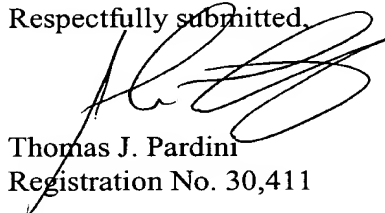
b. The second legal deficiency in the Final Office Action is the refusal to give patentable weight to the functional language of the controller recited in the rejected claims. The failure to give patentable weight to the description of the controller does not comply with the rules of Patent Examination. Rather, functional language that distinguishes a controller of the claims over the applied reference must be considered by the Patent Office. As stated in MPEP §2173.05g, "there is nothing inherently wrong with defining some part of an invention in function terms ... a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." (Emphasis added). One of ordinary skill in this art would understand that a controller which performs a particular function must be programmed or hard-wired, etc., in order to be capable of performing that function. Thus, the functional limitations in the claims, which defines the functions performed by the controller further limits the claims and further defines the structure of the controller. Moreover, there is no corresponding description of any such controller in the system of Nakamura, nor is there any indication that the controller in Nakamura is capable of performing the claimed functions, or is otherwise structured, to perform those functions. Thus, it is clear legal error not to give the functional limitations of a controller patentable weight during claim examination.

c. The third legal deficiency resides in rejecting the claims based on the allegation in the Final Office Action that "a user" may regulate operation of the air delivery system in Nakamura through the messages displayed on the display device because a requirement of human intervention precludes anticipation. *In re Prater*, 415 F.2d 1393, 1406. Moreover, an apparatus claim reciting the functionality of a properly programmed digital

computer does not encompass a human being as performing the function. *Id.* at 1405-1406. Furthermore, functional language describing a computer in a system claim may not include intervention by a human being because "the case law precludes a conclusion that a human being is a corresponding structure, or an equivalent to a structure under 35 U.S.C. §112, paragraph 6." *Default Proof Credit Card System, Inc. v. Home Depot USA, Inc.*, 412 F.3d 1291, 1297. Thus, it is legal error to reject the claims relying upon "a user," e.g., a human, as in Nakamura to regulate operation of an air delivery system.

For at least these reasons, the Final Office Action includes legal and factual deficiencies and also fails to establish a *prima facie* case of anticipation due to omission of an essential element. Because the prior art fails to disclose each and every feature recited in the pending claims, withdrawal of the Final Rejection and allowance of this application is respectfully requested.

Respectfully submitted,



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